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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/623,956	07/21/2003	Zoltan David	ZOL150/4-001CONUS/20000	4611
21586	7590	05/09/2005	EXAMINER	
VINSON & ELKINS, L.L.P. 1001 FANNIN STREET 2300 FIRST CITY TOWER HOUSTON, TX 77002-6760			COMPTON, ERIC B	
			ART UNIT	PAPER NUMBER
			3726	

DATE MAILED: 05/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/623,956

Applicant(s)

DAVID, ZOLTAN

Examiner

Eric B. Compton

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Priority

1. It is noted that this application appears to claim subject matter disclosed in prior Application No. 09/934,257 filed August 21, 2001. A reference to the prior application must be inserted as the first sentence(s) of the specification of this application or in an application data sheet (37 CFR 1.76), if applicant intends to rely on the filing date of the prior application under 35 U.S.C. 119(e) or 120. See 37 CFR 1.78(a). For benefit claims under 35 U.S.C. 120, the reference must include the relationship (i.e., continuation, divisional, or continuation-in-part) of all nonprovisional applications. Also, the current status of all nonprovisional parent applications referenced should be included.

If the application is a utility or plant application filed under 35 U.S.C. 111(a) on or after November 29, 2000, the specific reference to the prior application must be submitted during the pendency of the application and within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior application. If the application is a utility or plant application which entered the national stage from an international application filed on or after November 29, 2000, after compliance with 35 U.S.C. 371, the specific reference must be submitted during the pendency of the application and within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) or sixteen months from the filing date of the prior application. See 37 CFR 1.78(a)(2)(ii) and (a)(5)(ii). This time period is not extendable and a failure to submit the reference required by 35 U.S.C.

119(e) and/or 120, where applicable, within this time period is considered a waiver of any benefit of such prior application(s) under 35 U.S.C. 119(e), 120, 121 and 365(c). A benefit claim filed after the required time period may be accepted if it is accompanied by a grantable petition to accept an unintentionally delayed benefit claim under 35 U.S.C. 119(e), 120, 121 and 365(c). The petition must be accompanied by (1) the reference required by 35 U.S.C. 120 or 119(e) and 37 CFR 1.78(a)(2) or (a)(5) to the prior application (unless previously submitted), (2) a surcharge under 37 CFR 1.17(t), and (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2) or (a)(5) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional. The petition should be addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 10 recites the limitation "the beads projecting from the metal surface" in line 1. There is insufficient antecedent basis for this limitation in the claim. It appears this limitation is introduced in claim 2.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 3-5, 11, 13-15, and 20-21, are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Pat. 2,747,259 to Brioux.

Regarding claim 1, Brioux discloses a method of ornamenting a metal surface comprising:

(a) obtaining an object comprising an accepting metal having a metal surface (1);

(b) creating one or more holes, channels, or negative spaces (4) within the metal surface; and

(c) filling said holes or negative spaces with a second metal (6).

Regarding claim 11, Brioux discloses a method of ornamenting a metal surface comprising:

(a) obtaining an object comprising an accepting metal having a metal surface (1);

(b) marking the metal surface with a desired decorative pattern (8);

(c) creating one or more holes, channels, or negative spaces (4) within the metal surface where the metal surface has been marked; and

(d) filling said holes or negative spaces with a second metal (6).

Regarding claim 20, see Figure 5 of Brioux. "[E]ven though product-by process claims are limited by and defined by the process, determination of patentability is based

on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted).

Regarding claims 3-5, 13-15 and 21, Brioux discloses the blank material (1) may be formed of yellow gold and the inserts (6) may be made of while, green and/or red gold. See Col. 2, lines 52-54.

6. Claims 1, 3-7, 11, 13-17, and 20-21, are rejected under 35 U.S.C. 102(b) as being anticipated by a book entitled “Creative Gold- and Silversmithing” by Sharr Choate (“Choate”).

Regarding claim 1, Choate discloses a method of ornamenting a metal surface comprising (see e.g., page 143, Fig. 259):

- (a) obtaining an object comprising an accepting metal having a metal surface;
- (b) creating one or more holes, channels, or negative spaces within the metal surface; and
- (c) filing said holes or negative spaces with a second metal.

Regarding claim 11, Brioux discloses a method of ornamenting a metal surface comprising (see e.g., page 143, Fig. 259):

- (a) obtaining an object comprising an accepting metal having a metal surface;
- (b) marking the metal surface with a desired decorative pattern;

(c) creating one or more holes, channels, or negative spaces within the metal surface where the metal surface has been marked; and

(d) filing said holes or negative spaces with a second metal.

Regarding claims 3-5, 13-15 and 21, Choate discloses the metal surface may be formed one metal and the second metal from another metal. Page 143.

Regarding claims 6 and 16, Choate discloses, "Metals can be inlaid with solder [i.e., a melted metal] alone. Silver solder is used in gold, copper and steel, and brass solder is used in copper, steel and iron." Page 143.

Regarding claims 7 and 17, as shown in Figure 261, Page 145, gold and silver wire may be hammered into grooves to form the inlay.

Regarding claims 20-21, see Figure 259 of Choate. "[E]ven though product-by process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted).

Claim Rejections - 35 USC § 103

7. Claims 2, 8-10, 12 and 18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Choate.

Choate discloses the invention cited above. However, the reference does not explicitly disclose "shaping the second metal into one or more beads projecting from the metal surface."

Choate provides a chapter "Chasing and Repousse" on surface texturing and ornamentation. "Chasing is the use of a short chisel-like tool which indents a prescribed line on the surface to stress the main aspects of a design, and to define detailed areas." Page 171. Furthermore, the reference teaches, "Cushioning or embossing **tools are used for raising bumps and ridges** in varying sizes form wide to narrow, from square to round to pear-shaped." Page 172 (emphasis added).

Regarding claims 2, 10, and, 12, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have shaped the second metal into one or more beads projecting from the metal surface, in light of the teachings of Choate, in order to form a raised ornamental design. See *In re Seid*, 161 F.2d 229, 73 USPQ 431 (CCPA 1947) (The court found that matters relating to ornamentation only which have no mechanical function cannot be relied upon to patentably distinguish the claimed invention from the prior art.).

Regarding claims 8, 9 and 18-19, Figure 286, Page 173 shows a steel punch having a concave point. See also Figure 287, Page 173 (showing the same tool that Applicant describes).

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Double Patenting

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 2, 8-10, 12 and 18-19 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 and 11-15 of U.S. Patent No. 6,594,901. Although the conflicting claims are not identical, they are not patentably distinct from each other because they shaping the second metal to form projecting beads and domes. The fact that the patent claims, "shaping only the second metal ... within the boundary edges of the holes, channels or other negative spaces." is merely an ornamental/design choice. See *In re Seid*, 161 F.2d 229, 73 USPQ 431 (CCPA 1947) (The court found that matters relating to ornamentation only which have no mechanical function cannot be relied upon to patentably distinguish the claimed invention from the prior art.).

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Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric B. Compton whose telephone number is (571) 272-4527. The examiner can normally be reached on M-F, 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter D. Vo can be reached on (571) 272-4690. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Eric B. Compton
Primary Examiner
Art Unit 3726

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